

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DEBRA J. BATTAH, TERRY W. LEWIS, and JOHN E. RIEDEL

Appeal No. 2004-0446
Application No. 09/747,601

ON BRIEF

Before GARRIS, MOORE, and POTEATE, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-30 which are all of the claims in the application.

The subject matter on appeal relates to a method of making adhesive wound closure material or device as well as to the device resulting from this method. This appealed subject matter is adequately illustrated by independent claim 1 which reads as follows:

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1. A method of making adhesive wound closure material, the method comprising:

providing a web that comprises a non-woven fabric comprising binder fibers;

bonding at least one longitudinal reinforcing fiber to the non-woven fabric, wherein the at least one reinforcing fiber is coextensive with a length of the web;

microcreping the non-woven fabric and the at least one reinforcing fiber so as to compress the non-woven fabric and the at least one reinforcing fiber along the length of the web; and

applying a layer of pressure sensitive adhesive to the web.

The references set forth below are relied upon by the examiner as evidence of obviousness:¹

Ewall	4,977,892	Dec. 18, 1990
Scholz	5,405,643	Apr. 11, 1995

¹In the "**Response to Argument**" section of the answer, the examiner has attempted to reinforce his obviousness conclusion by referring to and relying upon references which are not included in his statement of rejection. Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970) and the Manual of Patent Examining Procedure (MPEP) § 706.02(j) (Revision 1, February 2003). Therefore, in assessing the merits of the rejection before us, we will consider only the references included in the statement of the rejection.

Claims 1-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ewall in view of Scholz.²

We refer to the brief and reply brief and to the answer for a complete discussion of the contrary viewpoints expressed by the appellants and by the examiner concerning the above noted rejection.

OPINION

We will sustain this rejection for the reasons set forth below.

It is the examiner's finding that Ewall's method of making adhesive wound closure material corresponds to the methods defined by appealed independent claims 1 and 23 except for the here claimed step of microcreping the non-woven fabric and the reinforcing fibers. Regarding this claim distinction, the

²On page 7 of the Brief, the appellants state, "[f]or the purpose of this appeal, claims 1-22 stand or fall together and claims 23-30 stand or fall together." Consistent with this claim grouping, we will consider the obviousness issue advanced on this appeal in relation to independent claims 1 and 23 since these claims are the broadest and accordingly most representative claims within the aforementioned groups. With further regard to this matter and as a point of clarification, we will not consider the appellants' comments in the reply brief regarding certain dependent claims because these dependent claims have not been separately grouped by the appellants and therefore are not deserving of separate consideration. See Ex parte Schier, 21 USPQ2d 1016, 1018 (Bd. Pat. App. & Int. 1991) and 37 CFR § 1.192(c) (7) (2003).

examiner concludes that "it would have been obvious to one of ordinary skill in the art at the time [the] invention was made to modify the [method and] device of Ewall, to include the process of microcreping the non-woven fabric and the reinforcing fibers along the length of the web, as suggested by Scholz, for the purpose of providing stretchability and conformability to the fabric (col. 4, lines 32-35)" (answer, page 4).

The appellants disagree with the examiner's above noted finding in relation to the Ewall patent. More particularly, it is the appellants' view that the examiner improperly considers patentee's cover or backing layer 17 as readable on the reinforcing fibers required by the claims under review. According to the appellants, this is because "layer 17 of Ewall does not include any reinforcing fibers, but is, instead, a film" (brief, page 7).

The examiner properly concedes that patentee's layer 17 may be in the form of a film. However, as correctly explained by the examiner, Ewall also teaches (explicitly and repeatedly) that backing or cover layer 17 also may be in the form of a fabric. See lines 38-40 in column 3, lines 55-56 in column 4, lines 19-21 in column 5, lines 16-19 in column 6, lines 10-11 in column 14,

lines 57-59 in column 15, lines 39-41 in column 16, lines 19-21 in column 17 and lines 11-13 in column 18 of the Ewall patent.

In light of these explicit and repeated teachings of Ewall, we fully agree with the examiner's finding that patentee's layer 17 includes fabric embodiments and thus fibers which fully satisfy the reinforcing fibers requirements of appealed independent claims 1 and 23.

The appellants also disagree with the examiner's previously discussed conclusion of obviousness. It is the appellants' basic position that the applied prior art contains no teaching or suggestion for combining Ewall and Scholz (i.e., in the manner proposed by the examiner) based upon a reasonable expectation of success. As reflected by his aforequoted obviousness conclusion, the examiner believes an artisan with ordinary skill would have been motivated to provide the non-woven fabric and reinforcing fibers of Ewall with the microcreping technique taught by Scholz "for the purpose of providing stretchability and conformability to the fabric (col. 4, lines 32-35)" (answer, page 4). In response, the appellants advance the following argument on page 11 of the brief:

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While these characteristics (i.e., stretchability and conformability) may be beneficial to the casting tapes of Scholz, there is no indication that these properties would be of benefit to the absorbent wound dressings of Ewall. That is, there is no motivation or suggestion identified to combine the teachings of Scholz with Ewall as required to establish *prima facie* obviousness.

The appellants' argument is not well taken. The conformability characteristic, which is taught by Scholz to result from his microcreping technique, plainly is applicable to the wound dressing of Ewall particularly since this dressing is expressly described as being flexible and skin-conformable (e.g., see lines 16 and 52 in column 2). Moreover, the teachings of these references would have provided the artisan with a reasonable expectation of success especially since, as correctly noted by the examiner, the fabrics of both Ewall and Scholz may be formed from the same material, namely, polyester fibers. See In re O'Farrell, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1680-81 (Fed. Cir. 1988).

In light of the foregoing, it is our ultimate determination that the Ewall and Scholz references evince a prima facie case of obviousness with respect to appealed independent claims 1 and 23

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which the appellants have failed to successfully rebut with argument and/or evidence of nonobviousness. It follows that we will sustain the examiner's Section 103 rejection of claims 1-30 as being unpatentable over Ewall in view of Scholz. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

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The decision of the examiner is affirmed.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JAMES T. MOORE)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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)	
LINDA R. POTEATE)	
Administrative Patent Judge)	

BRG/hh

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